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10/032,414	12/21/2001	Patrick Bradd	584-1047	5733
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BARNES & THORNBURG, LLP			SHEW, JOHN	
P.O. BOX 2786			ART UNIT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/032,414	Applicant(s) BRADD ET AL.	
	Examiner John L. Shew	Art Unit 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/21/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Page 10 line 32 cites "server 18' " should be "server 18" " .

Page 11 line 3 cites "gateway 24" " should be "gateway 26" " .

Appropriate correction is required.

Claim Objections

2. MPEP 608.01(m) reads as follows:

Form of Claims

The claim or claims must commence on a separate *>physical sheet or electronic page< and should appear after the detailed description of the invention. >Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.< While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the **>Office of Patent Publication<. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36

USPQ2d 1211 (D.D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

Claims 16 and 17 are objected to because of the following informalities:

Claim 16 line 6 cites "terminal." should be "terminal," .

Claim 17 line 6 cites "terminal." should be "terminal," .

Claims 7, 8 are objected to because of the following informalities:

Claim 7 line 1 cites "intra-sever" should be "intra-server" .

Claim 8 line 1 cites "intra-sever" should be "intra-server" .

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 lines 1-2 recites the limitation "including a controller arranged to receive at the control port". There is insufficient antecedent basis for this limitation in the claim, since claim 8 upon which claim 10 depends does not define a control port.

Claim 13 line 4 recites the limitation "said first network". There is insufficient antecedent basis for this limitation in the claim, since there is no prior limitation of a first network.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11, 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Control signals are descriptive matter per se and are not statutory because they are neither physical "things" nor statutory processes. Such claimed control signal do not define any structural interrelationship between the control signal and the other claimed aspects of the invention which permit the control signal to be realized. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a

concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101 .

Claims 15 and 17 are are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Software is descriptive matter per se and are not statutory because it is neither physical “things” nor statutory processes. Such claimed software do not define any structural interrelationship between the software and the other claimed aspects of the invention. The software does not perform any pre or post computer processing. It is only a series of steps without any limitation to a practical problem. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101 .

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6, 8, 9, 10, 11, 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Borella et al. (Patent No. 6731642).

Claim 6, Borella teaches a call server (Fig. 1, Abstract lines 1-13) referenced by the Gatekeeper 30, for setting up VoIP calls over a packet-switched network (FIG. 1, Abstract lines 1-20) referenced by the Internet telephony call between a caller station and a callee station, comprising (a) a terminal controller arranged to receive a call set-up request from an originating terminal (Fig. 1, Fig. 3, col. 7 lines 65-67, col. 8 lines 1-8) referenced by the First Router 18 receiving a SETUP message 80 from the first telephony interface 22 of the Caller Station 24, (b) an address translator controller arranged to provide to an address translator (Fig. 1, Fig. 3) referenced by the First Router 18 sending a SETUP message 82 to the First Gatekeeper 30, the IP address of the originating terminal as derived from a call set-up request by the terminal controller (col. 4 lines 15-32, col. 5 lines 29-37, col. 8 lines 3-15) referenced by the forward setup message having the private caller address obtained from the original setup message.

Claim 8, Borella teaches including intra-sever communication means arranged to communicate with another call server (Fig. 1, Fig. 3, col. 8 lines 29-64) referenced by the First Gatekeeper 30 sending a Gatekeeper Setup message 92 to Second Gatekeeper 32, to obtain an IP address for a first address translator (col. 4 lines 15-32,

Fig. 3, col. 8 lines 54-67) referenced by the Lookup message 94 from the Second Gatekeeper 32 to the Back End Server 34 to obtain the public second router address and private callee address, which is in communication with a destination terminal under the control of the other call server (Fig. 1) referenced by the callee station 27 under the control of Gatekeeper 32, and wherein the address translator controller (Fig. 1) referenced by the First Router 18, is further arranged to provide the IP address of a second address translator (Fig. 1, Fig. 3, col. 8 lines 46-67, col. 9 lines 1-35) referenced by the Lookup Response 96 of the Second Gatekeeper 32 including the second router address, which is in communication with the originating terminal to the said first address translator and vice versa (Fig. 3, col. 9 lines 13-35) referenced by the established communication of the First Telephony Interface 80 via the First Router 18 to the Second Telephony Interface 28 in both directions.

Claim 9, Borella teaches an address translator (Fig. 1) referenced by the Router 18, comprising (a) a terminal port for communicating with a terminal (Fig. 1) referenced by the connection from the Router 18 to the Telephony Interface 22, (b) a translator port for communicating with another address translator (Fig. 1) referenced by the connection from Router 18 to Router 20 via IP ports, (c) a control port for communicating with a call server (Fig. 1) referenced by the connection from the Router 18 to the Gatekeeper 30.

Claim 10, Borella teaches a controller arranged to receive at the control port information relating to an IP address of another address translator (Fig. 1, Fig. 3, col. 8 lines 29-45)

referenced by the First Router 18 receiving an Allocate Address message 88 which contains the address of the first gatekeeper which performs address translations, which is reachable via the translator port (Fig. 1) referenced by the Router 18 in communication with Gatekeeper 30 via the IP backbone through IP ports, and corresponding information relating to an IP address of an originating terminal (Fig. 1, Fig. 3, col. 8 lines 29-45) referenced by the Address Response message 90 which includes the proxy public caller address, and to pass data received at the terminal port from the originating terminal to the corresponding address translator via the translator port (Fig. 3) referenced by the established Connection between the Second Telephony Interface 28 to the First Telephony Interface 22 via the First Router 18 translator and wherein the data is passed through the Router 18 terminal port.

Claim 11, Borella teaches a control signal for (Fig. 2, col. 7 lines 15-37) referenced by the Registration message 52, for generating a mapping in an address translator (Fig. 2, col. 7 lines 24-49) referenced by the First Gatekeeper 30 sending a Registration message 54 to associate at the Server 34 the caller station number with the private caller address the first router address and the first gatekeeper address, between an originating terminal and another address translator (Fig. 2, col. 7 lines 24-49) referenced by the Registration message 54 to associate at the Server 34 the originating caller station number with the private caller address the first router address and the translator first gatekeeper address, which is in communication with a desired destination terminal (Fig. 3, col. 7 lines 63-67, col. 8 lines 1-53) referenced by the Gatekeeper Setup

message 92 between gatekeepers to establish communication with Second Telephony Interface 28.

Claim 12, Borella teaches a control signal for (Fig. 2, col. 7 lines 15-62) referenced by the Registration message 62, for generating a mapping in an address translator (Fig. 2, col. 7 lines 24-62) referenced by the Second Gatekeeper 32 sending a Registration message 66 to associate at the Server 34 the callee station number with the private callee address the second router address and the second gatekeeper address, between a destination terminal and another address translator which is in communication with an originating terminal (Fig. 3, col. 7 lines 63-67, col. 8 lines 1-53) referenced by the Gatekeeper Setup message 92 between gatekeepers to establish communication with First Telephony Interface 22.

Claims 14, 15, 16, 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Read (Pub. No. 2004/0037268).

Claim 14, Read teaches a method of setting up a call between two packet-switched networks having overlapping address ranges (Fig. 1, page 1 paragraph [0013], page 4 paragraphs [0074]-[0076]) referenced by the making of a multimedia call between

Enterprise A network with User A1 at IP address 10.1.1.1 and Enterprise B network with User B1 at IP address 10.1.1.1 which are overlapping, comprising (a) receiving a call setup request from a terminal in a first of the networks the call being destined for a terminal in the second network (Fig. 1, Fig. 2, page 5 paragraphs [0084]-[0085], page 6 paragraph [0086]-[0087]) referenced by the User A1 placing a multimedia call to user B1 by sending a setup message 50 containing the identities of A and B, (b) providing the terminal with the address of an address translator in the first network for use as the terminal's destination address (Fig. 1, Fig. 7) referenced by the Proxy Server 42 connect message 56 to Terminal A with the IP address 45.6.7.8/2777 as the translator address to make the H.245 connection, (c) notifying the address translator of an address to which data received from the terminal should be passed (Fig. 1, Fig. 8, page 6 paragraphs [0104]-[0105]) referenced by the terminal A1 10 establishing H.245 communications connections 58 59 with the Proxy Server 42 wherein the Proxy Server 42 makes similar connections 60 61 to terminal B1 12 for passing data.

Claim 15, Read teaches software for a call server when executed on suitable hardware (Fig. 1, Fig. 2, page 5 paragraphs [0084]-[0085]) referenced by the H.323 software used by Terminal A1 10 to the call server Router 32 which must use corresponding H.323 software for communications, causes the hardware to carry out the steps of (a) receiving a call setup request from a terminal in a first of the networks the call being destined for a terminal in the second network (Fig. 1, Fig. 2, page 5 paragraphs [0084]-[0085], page 6 paragraph [0086]-[0087]) referenced by the User A1 placing a

multimedia call to user B1 by sending a setup message 50 containing the identities of A and B, (b) providing the terminal with the address of an address translator in the first network for use as the terminal's destination address (Fig. 1, Fig. 7) referenced by the Proxy Server 42 connect message 56 to Terminal A with the IP address 45.6.7.8/2777 as the translator address to make the H.245 connection, (c) notifying the address translator of an address to which data received from the terminal should be passed (Fig. 1, Fig. 8, page 6 paragraphs [0104]-[0105]) referenced by the terminal A1 10 establishing H.245 communications connections 58 59 with the Proxy Server 42 wherein the Proxy Server 42 makes similar connections 60 61 to terminal B1 12 for passing data.

Claim 16, Read teaches a method of translating addresses between terminals in first and second packet-switched networks having overlapping address ranges (Fig. 1, page 1 paragraph [0013], page 4 paragraphs [0074]-[0076]) referenced by the making of a multimedia call between through Network Address Translations between Enterprise A network with User A1 at IP address 10.1.1.1 and Enterprise B network with User B1 at IP address 10.1.1.1 which are overlapping, comprising (a) receiving notification from a call server of the address of a terminal which will be sending data (Fig. 1, Fig. 3, page 5 paragraphs [0084]-[0085], page 6 paragraphs [0086]-[0089]) referenced by the Proxy Server 40 receiving from the Router 32 sending a setup message 51 which contains the identity of caller A, (b) receiving notification of an address to which data should be sent when received for the terminal (Fig. 1, Fig. 3, page 5 paragraphs [0084]-[0085], page 6

paragraphs [0086]-[0089]) referenced by the Proxy Server 40 receiving from the Router 32 sending a setup message 51 which contains the identity of callee B, (c) receiving data from the terminal and forwarding the data to the notified destination address (Fig. 1, Fig. 8, page 6 paragraphs [0104]-[0105]) referenced by the terminal A1 10 establishing H.245 communications connections 58 59 with the Proxy Server 42 wherein the Proxy Server 42 makes similar connections 60 61 to terminal B1 12 for passing data.

Claim 17, Read teaches software for an address translator which when executed on suitable hardware (Fig. 1, Fig.2, page 5 paragraphs [0084]-[0085]) referenced by the H.323 software used by Terminal A1 10 to the call server Router 32 and subsequently the Proxy Server 42 which must use corresponding H.323 software for communications, to carry out the steps of (a) receiving notification from a call server of the address of a terminal which will be sending data (Fig. 1, Fig. 3, page 5 paragraphs [0084]-[0085], page 6 paragraphs [0086]-[0089]) referenced by the Proxy Server 40 receiving from the Router 32 sending a setup message 51 which contains the identity of caller A, (b) receiving notification of an address to which data should be sent when received for the terminal (Fig. 1, Fig. 3, page 5 paragraphs [0084]-[0085], page 6 paragraphs [0086]-[0089]) referenced by the Proxy Server 40 receiving from the Router 32 sending a setup message 51 which contains the identity of callee B, (c) receiving data from the terminal and forwarding the data to the notified destination address (Fig. 1, Fig. 8, page 6 paragraphs [0104]-[0105]) referenced by the terminal A1 10 establishing H.245

communications connections 58 59 with the Proxy Server 42 wherein the Proxy Server 42 makes similar connections 60 61 to terminal B1 12 for passing data.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borella as applied to claim 1 above, and further in view of Read (Pub. No. 2004/0037268).

Claim 7, Borella teaches including intra-sever communication means arranged to communicate with another call server (Fig. 1, Fig. 3, col. 8 lines 29-64) referenced by the First Gatekeeper 30 sending a Gatekeeper Setup message 92 to Second Gatekeeper 32, to obtain an address for a destination terminal (Fig. 1, Fig. 3, col. 8 lines 54-64) referenced by the lookup of the callee station number in the Server 34 database, which is under the control of the other call server (Fig. 1) referenced by the callee station 27 under the control of Gatekeeper 32. Borella does not disclose obtaining an IP address and port for a destination terminal.

Read discloses a call server (Fig. 1) referenced by the Service Centre 40, obtaining an IP address and port for a destination terminal (Fig. 4, page 6 paragraphs [0091]-[0093]) referenced by the setup message of the TCP packet with the source and destination IP address and port number, and wherein the address translator controller (Fig. 1) referenced by the Router 32, is further arranged to provide the IP address and port of the destination terminal to an address translator (Fig. 3, page 6 paragraphs [0088]-[0090]) referenced by the router 32 sending a message to the Proxy Server 42 including the H.323 information of the destination IP address and port number for address translation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the network address translation telephony method of Read to the internet telephony system of Borella for the purpose of making a multimedia call over a shared communications network including a firewall through which the multimedia call must pass as suggested by Read (Abstract lines 1-7).

Claim 13, Borella teaches a packet-switched network (Fig. 1, col. 3 lines 50-52) referenced by the Internet telephony system, having a call server (Fig. 1) referenced by the First Gatekeeper 30, a terminal (Fig. 1) referenced by the First Telephony Interface 22, and an address translator (Fig. 1) referenced by the First Router 18, the call server being arranged to control the address translator and to generate a mapping in the address translator between the address of the terminal in the said first network and the address of another network address translator outside of the first network (Fig. 1, Fig. 3,

col. 7 lines 63-67, col. 8 lines 1-53) referenced by the Gatekeeper Setup message 92 between gatekeepers to establish the address allocations between First Telephony Interface 22 of the first network and the Second Telephony Interface 28 of the second network, the address translator being arranged to communicate with the other address translator to allow communication with another terminal in another network (Fig 3, col. 9 lines 52-67, col. 10 lines 1-19) referenced by the First Router 18 establishing communication with the Second Router 20 through the Connect message 112. Borella does not teach communication with another network having an IP address which overlaps that of the first network.

Read teaches an address translator (Fig. 1, page 4 paragraphs [0074]-[0076]) referenced by the Router 32 with Network Address Translation rules, being arranged to communicate with the other address translator (Fig. 1, page 4 paragraphs [0074]-[0076]) referenced by Router 34, to allow communication with another terminal in another network (Fig. 1, page 4 paragraphs [0074]-[0076]) referenced by the Terminal 12 of Enterprise B network, having an IP address range which overlaps with that of the first network (Fig. 1, page 4 paragraphs [0074]-[0076]) referenced by the IP address of User A1 Terminal 10 set at 10.1.1.1 and the IP address of User B1 Terminal 12 set at 10.1.1.1 which is an overlapping address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the network address translation telephony method of Read to the internet telephony system of Borella for the purpose of making a multimedia call

over a shared communications network including a firewall through which the multimedia call must pass as suggested by Read (Abstract lines 1-7).

Allowable Subject Matter

7. Claims 1-5 are allowed.

Citation of Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pub. No. 2002/00152325, Elgebaly et al. discloses communication protocols operable through network address translation type devices. Pub. No. 2003/0009561, Sollee discloses providing telephony services to terminals behind a firewall and network address translator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Shew whose telephone number is 571-272-3137. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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